



REMARKS AND ARGUMENTS

Applicant respectfully requests reconsideration of Application in view of the following remarks and with reference to Claims and remarks submitted on July 4, 1999. Applicant confirm the canceling of Claims 1-28 originally presented, and renumbering of newly submitted Claims as 35-60. Therefore, current four (4) independent pending Claims so numbered are, respectively, 35, 37, 44, and 51 which, together with those dependent therefrom, stand rejected. Accordingly, Claims 35-60 are presented for further consideration without amendment thereto.

I. CORRECTION OF THE OFFICE ACTION

During telephone conversations with Mr. J. Paradiso (Examiner) on 09/24/99 and 10/13/99 and with Ms. V. Wallace (Supervisory Examiner) on 10/12/99, an error on the "Office Action Summary" page of the Action dated August 02, 1999 has been pointed out. Applicant has not yet received written confirmation for correction thereof. More errors have been found in said Office Action after further review by Applicant. Therefore, Applicant respectfully requests confirmation and correction of the following typographical or clerical errors so uncovered pursuant to 37 C.F.R. § 1.111(b) :

- (0.1) Checked Box for indicating *"This action is FINAL"* (2nd line of the middle box on Page 1, or the front "Office Action Summary" page), which is incorrect, as the parties agreed during said telephone conversations on 09/24/99, 10/12/99, and 10/13/99.
- (0.2) "...*patent Application No. 08/831,342*" (2nd line of Section 1 on Page 2), which should be "...*patent Application No. 08/833,342*"
- (0.3) "*Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312*" (3rd line of Section 2 on Page 2), which, APPLICANT believe, is incorrect, since the 37 CFR § 1.312 is provided for "Amendments after Allowance"
- (0.4) "*b) Claims numbered 1-26, submitted on 7/2/99 as a Preliminary Amendment ..*" (3rd line of Section 3 on Page 2), wherein, the term "preliminary" is incorrect, since the term "formal" is shown at the front page of said submission; and wherein, the date is incorrect, since APPLICANT's record shows that the new Claims were submitted on 7/4/99, a Federal holiday, and the date stamped thereon shall be the next succeeding business day. (37 CFR § 1.6(a)(3)).

- (0.5) "The following papers were entered on 7/2/99 as.." (1st line of Section 5 on Page 3), wherein the date is incorrect. (See subsection (0.4) hereinabove)
- (0.6) "Claims 36 and 38-4 are rejected ..." (1st line of Section 11 on Page 6), wherein the Claim number "38-4" is certainly incorrect.
- (0.7) "Applicant's arguments filed 7/2/99....." (1st line of Section 13 on Page 8), in which, again, the date is incorrect (see subsection (0.4) hereinabove).
- (0.8) The stamp* showing "Valencia Martin-Wallace, Primary Examiner" (Lower right portion of Page 9)

Note:

- * According to the one-time tele-conference with Ms. Valencia Martin-Wallace on October 12, 1999, it was apparent to Applicant that Ms. Wallace is the Supervisory Examiner of the group, and was not acting as a Primary Examiner for the present application.

II. REJECTION UNDER 35 U.S.C. § 102(b) and 103(a)

- (1) (1.1) Applicant respectfully traverses the rejection of Claims 35, 37, and 43, as being anticipated by Tong, under 35 U.S.C. § 102(b) which required that the prior art invention was patented "more than one year prior to the date of the application.." The non-provisional application filing date of the present case is April 4, 1997, which is more than two month earlier than the patent date of TONG; and the provisional application filing date is April 5, 1996, which is fourteen month earlier than TONG's patent date.

(1.2) In addition, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

(1.3) Applicant also traverses the rejection of Claims 36, 38, and 44-60 as being unpatentable over TONG under 35 U.S.C. § 103(a), as explained in GROUND OF TRAVERSE section

- (2) Applicant have noticed that most of the arguments in the Office Action dated 08/02/99 (hereinafter "ACTION") are identical to the previous Office Action dated 11/10/99 (hereinafter

"PREVIOUS ACTION"), and there is no new ground of rejection provided in the ACTION. In order for Applicant to properly reply to the ACTION under 37 C.F.R. § 1.111(b), Comparison between the ACTION and the PREVIOUS ACTION is shown as follows:

(2.1) The first paragraph of Page 5 (under Section No. 9) of the ACTION is the same as the last paragraph of Page 3 (under Section No. 4) of the PREVIOUS ACTION except for the added phrase *"in which actuators to move the doll's body parts"* (2nd line);

(2.2) The second paragraph of Page 5 (under Section No. 9) of the ACTION is identical to the first paragraph of Page 4 (under Section No. 4) of the PREVIOUS ACTION;

(2.3) The third paragraph of Page 6 (under Section No. 11) of the ACTION is the same as the second paragraph of Page 6 (under Section No. 5) of the PREVIOUS ACTION except for the first word *"However"* in place of the phrase *"Regarding claims 15, 16, 26, and 27"*;

(2.4) The last paragraph of Page 6 (under Section No. 12) of the ACTION is identical to the third paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION;

(2.5) The last paragraph of Page 7 (under Section No. 12) of the ACTION is identical to the last paragraph of Page 5 (under Section No. 5) of the PREVIOUS ACTION;

(2.6) The third paragraph of Page 8 (under Section No. 14) of the ACTION is substantially identical to the last paragraph of Page 6 (under Section No. 7) of the PREVIOUS ACTION.

(2.7) Applicant have also recognized that the arguments described hereinabove in this section are completely irrelevant to the newly presented Claims 35-60. Therefore, unless Examiner provides evidence proving to the contrary, Applicant concludes that the ACTION is a falsified document, which is also supported by Section (3) hereinbelow. Examiner's lack of response hereto would render his/her agreement hereupon.

(3) In the ACTION, as Applicant have noticed, section 7 on Page 4, section 15 on Page 8, and section 16 on Page 9 are the only three argument sections with discussions therein not found in the PREVIOUS ACTION. However,

(3.1) the only argument of said section 15 on Page 8 is making a reference to another section or paragraph;

(3.2) in said Section 16 on Page 9, Examiner's only argument is *"However, the claims do not recite adjusting the frequency of the image-actuation control in that matter"*, such an argument is completely irrelevant to any of the Claims, since *"frequency of the image-actuation control in that*

matter" does not belong to any part of the subject matter of the present invention;

(3.3) In said Section 7 on Page 4, Examiner states : "*In Claim 42 lines 2-3, it is unclear what is meant by 'means for transferring said external...signal..to a drive-control signal sequence ..' "*";

Nevertheless, the discussion of digital-signal transfer can be found in the specification;

(3.4) As described hereinabove, arguments in all other sections of the ACTION are essentially the same as the PREVIOUS ACTION.

(3.5) Therefore, Applicant concludes, and vehemently object to, that Examiner has, in the ACTION, ignored and is completely unresponsive to Applicant's newly submitted Claims and arguments.

(3.6) "The examiner's action will be complete as to all matters" (37 C.F.R. § 104(b)). The discussions in Section (2-3) herein shows that in the ACTION, Examiner does provided ground of rejection for each and every claim rejected, and have ignored most matters set forth in newly submitted Claims (35-60). Therefore, Applicant concludes that the ACTION, or the Office Action dated 08/02/99, is incomplete. Examiner's lack of response hereto would render his/her agreement hereupon.

III. GROUND OF TRAVERSE

Again, Applicant traverses all rejections of Claims, under 35 U.S.C. § 103, as being unpatentable over TONG and/or in further view of GASPER et al, with ground thereof further explained, in reference to Claims 34-60 and Remarks submitted on 07/04/99 (hereinafter "REMARKS"), as follows:

(4) Non-analogous Art

(4.1) "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986);

(4.2) According to Sections 1 and 4 of the REMARKS, and to preambles of Claims 35, 37, and 44 and the background and summary sections of the specification, TONG is not pertinent to such particular problem, with which the present invention is concerned, as to provide a toy figure

that is "responsive to receiving an external digital animation-control signal sequence...", instead of reacting to receiving an analog signal from a computer.

(4.3) With regard to evidence of "nonanalogy", the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Therefore, arguments in Section (5) hereinbelow is a showing that both TONG and GASPER are non-analogous references.

(4.4) Pursuant to 37 C.F.R. § 1.104 (c), Applicant respectfully request that Examiner clearly describe the pertinence of each reference, and clearly explain each rejected claim.

(5) Different Structures and Functions

(5.1) Structural differences between the present invention and said prior art references are apparent when comparing the newly submitted Claims 35-60 with prior art Claims. Said comparison also illustrates functional differences therebetween. Additionally, in Sections 5-9 of the REMARKS, Applicant has provided extensive description of new and different functions of the present inventions.

(5.2) Examiner have ignored and is unresponsive to almost all points of arguments in the REMARKS, as described in Section (2-3) hereinabove, which is a showing that Examiner agrees with said arguments. However, **Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument herein and in the REMARKS regarding said differences.**

(5.3) Therefore, the aforesaid new and different functions, as well as said structural differences, of the present invention render its non-obviousness, which is evidenced by the Court decisions in both the Sakraida v. Ag Pro, Inc., 425 U.S. 273, 189 USPQ 449, reh'g denied, 426 U.S. 955 (1976) and Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 163 USPQ 673 (1969).

(6) Claim Limitations Not Being Taught or Suggested in Prior Art

(6.1) In order to constitute prima facie obviousness of an invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

(6.2) Furthermore, if an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

(6.3) In present case, TONG and GASPER certainly do not teach nor suggest all Claim Limitations of the present application.

(7) Proposed Modification Not Feasibility

(7.1) If alleged modification would render functions of the prior art invention being modified unfeasible or unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In present case, (7.2) not only the prior art references do not have the same purposes as the present invention, as described in section (4) hereinabove; (7.3) the alleged combination by the examiner for obtaining results or effects of the present invention is not functional feasible, as described in Sections 8-9 of the REMARKS.

(7.4) Furthermore, It is not feasible to simply changed the DC motor of TONG to a solenoid, because the electronic driving system provided therein can not be used to control a solenoid, which is obvious to one having ordinary skill in the art.

(8) Superiority of Properties: Absence of Prior Art Properties

As described in the REMARKS, the present invention possesses several functions and properties that are clearly superior to the prior art inventions, including, but not limited to,

(8.1) Movement of toy's second body part being independent of that of the first body part so as to be realistic, instead of all said body parts being moving concurrently and dependently; which can also be understood as absence of the property of said concurrent and dependent moving in the present invention based on the teachings of the prior art.

(8.2) Toy figure being responsive to receiving digital animation-control signal;

(8.3) Accurate control of movement of toy figure's mouth according to detailed textual content of the doll's speech, such as arrangement of vowel letters therein;

(8.4) Controlling the movement of toy figure's body part without presence or input of any sound signal;

(8.5) Selectively activating toy figure's body part according to user's demand instead of

being solely controlled by the amplitude of the sound signal input, which can also be understood as absence of the property of said solely controlling in the present invention based on the teachings of the prior art;

(8.6) It is understood that presence of a superior property or property not possessed by the prior art or unexpected or greater than expected result are evidence of non-obviousness. In re Corkill, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963); Chupp, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987); See also Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961); Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

(8.7) In addition, absence of a property which the present invention would have been expected to possess based on the teachings of the prior art also renders unobviousness of the invention. Ex parte Mead Johnson & Co. 227 USPQ 78 (Bd. Pat. App. & Inter. 1985)

(9) Subject Matter as a Whole (35 U.S.C. § 103)

In previous two Office Actions, Examiner particularly point out the use of solenoid as being "obvious". However,

(9.1) "In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification..... it is this invention as a whole, and not some part of it, which must be obvious under 35 USC 103." In re Antonie, 559 F.2d 618, 620, 195 USPQ 6,8 (CCPA 1977); see also Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ-698 (Fed. Cir. 1983)

(9.2) Furthermore, solenoid is not a commonly used device for actuating moving part of a doll in the toy industry, as described in Section (11) hereinbelow.

(10) Lack of Suggestion or Motivation to Modify the References:

(10.1) Applicant agree that the invention of TONG can be modified. However, in order to obtain all the results of the present invention, such modification needs to be substantial, i.e., (a) the entire internal structure and arrangement of the toy figure of TONG needs to be changed, and (b) the

computer software program also needs to be replaced.

(10.2) Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither TONG nor GASPER teaches said suggestion or desirability.

(11) Lack of Success of Others (Secondary Considerations)

(11.1) According to Applicant's experience and observation, solenoid is not a commonly used device for actuating moving mouth of a doll in the toy industry; In fact Applicant does not notice any product of this type currently exists in the market; Other than one of the prior art references (NOLL) recited in the Office Action dated 04/30/98, Examiner has not yet provide evidence of any kind (such as name and manufacture of a product), for proving to the contrary.

(11.2) There is still no product in the market that is similar to the present invention which was invented more than three years ago.

(11.3) Therefore, there is no evidence for supporting reasonable expectation of success for the proposed modification by the Examiner at the time present invention was made, which apparently substantiate the conclusion that present invention is nonobvious. In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

IV. ENSUING OFFICE ACTION; REQUEST

(12) Ground of Rejection - General

Applicant respectfully request that in determine the obviousness or non-obviousness matters of the present invention, Examiner relies upon the Graham three pronged test. The Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .

(13) Response to All Arguments

(13.1) Each and every section and subsection herein has been carefully labeled in numerical or alphabetic order for the convenience of Examiner. All Section of the REMARKS submitted on 07/04/99 are also labeled.

(13.2) Applicant respectfully requests, and insists, that Examiner explicitly addresses (either agree or point out the exact portion that he/she is opposed to), in the ensuing Office Action, each and every point of argument in this Remarks and Arguments and in the previously submitted REMARKS. (Repeat).

(13.3) Lack of response to any argument herein or in the REMARKS will render examiner's agreement with said agreement.

(13.4) Applicant respectfully request that Examiner do not present conflict argument resulting said lack of response.

(14) Ground of Rejection -Legal Precedent

(14.1) Applicant has provided Legal Precedent in support the arguments herein, and respectfully request that Examiner do the same should he/she is opposed to any of said arguments.

(14.2) "The value of the exceedingly large body of precedent wherein our predecessor courts and this court have applied the law of obviousness to particular facts, is that there has been built a wide spectrum of illustrations and accompanying reasoning, that have been melded into a fairly consistent application of law to a great variety of facts." In re Eli Lilly & Co., 902 F.d. 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

V. CONCLUSION

(15) For the foregoing reasons, reconsideration of the application, as submitted on 07/04/99, including a substitute specification and new Claims 35-60, without amendment thereto, pursuant to 37 C.F.R. § 1.112, is respectfully requested.

Should any fee be due with respect to this filing, please inform the examiner in writing at the address hereinbelow.

Respectfully submitted,

S.M.

By: 

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